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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,285	11/20/2001	Noboru Konno	F-7179	1073

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EXAMINER

WON, MICHAEL YOUNG

ART UNIT PAPER NUMBER

2155

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,285

Applicant(s)

KONNO ET AL.

Examiner

Michael Y. Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

69

DETAILED ACTION

1. This action is in response to the amendment filed July 5, 2005.
2. Claims 3-4 have been cancelled and claim 1-2 and 5-9 have been examined and remain pending with this action.
3. Applicant's arguments filed January 4, 2005 with respect to claims 1, 3 and 4 have been fully considered but they are not persuasive. See claim rejections and response to arguments below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, and 5-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Bromberg et al. (US 6,529,889 B1).

INDEPENDENT:

As per *claim 1*, Bromberg teaches a system (see abstract) for supporting knowledge creation and managing knowledge assets (see col.4, lines 2-11) by using four evaluation templates (see col.25, lines 17-26 and 64-67) wherein a member of an organization is evaluated (see col.11, lines 46-47: "evaluation process") accordingly to each of said four evaluation templates (implicit: see col.25, lines 18-22 and reference locations provided below), inputting obtained results from said evaluation templates into a computer (see col.10, lines 35-43 and col.38, lines 15-17), and analyzing results to show how said member acts in the actual situation (see col.4, lines 15-17; col.6, lines 29-34; and col.19, line 61-col.20, line 5), said four evaluation templates comprising:

a socialization evaluation template for evaluating a socialization process to capture tacit knowledge (see col.8, lines 30-32) inside and outside the organization (see col.8, lines 30-32 and col.10, lines 35-40 & 49-50);

an externalization evaluation template for evaluating an externalization process to express tacit knowledge (see col.8, lines 30-32) in a comprehensible way (subjective) and convert it into explicit knowledge (see col.10, lines 43-48, 50-53, & 60-63);

a combination evaluation template for evaluating a combination process to relate such explicit knowledge to other pieces of explicit knowledge inside and outside the organization (see col.13, lines 32-35 and col.38, lines 20-22); and

an internalization evaluation template for evaluating an internalization process to convert explicit knowledge into tacit knowledge (see col.8, lines 30-32) though practice (see col.6, lines 39-46; col.11, lines 56-65; col.29, lines 11-23; and col.38, lines 24-26);

said system further comprising a tacit knowledge (see col.8, lines 30-32) expression template (see col.25, lines 64-67), said tacit knowledge expression template being read and output by a computer as a reference syntax for expressing tacit knowledge in the externalization process (see col.10, lines 60-63);

a glossary for a tacit knowledge expression template in said database, said glossary being read and output by a computer (see col.8, lines 33-36 and col.24, lines 29-33), terms included in said glossary being applicable to said tacit knowledge expression template (see col.5, lines 27-40; col.23, lines 57-64; col.25, lines 30-33; and col.26, lines 29-31); and

said glossary providing terms for responding to inquiries (see col.8, lines 33-36: "searchable" and "include pointers") so that tacit knowledge is converted into explicit knowledge (see col.10, lines 43-48, 50-53, & 60-63) in a common format (inherent).

As per **claim 2**, Bromberg teaches a system (see abstract) for supporting knowledge creation and managing knowledge assets (see col.4, lines 2-11) comprising:

a database (see col.3, lines 49-53 and col.8, lines 8-10) including a socialization evaluation template for evaluating a socialization process to capture tacit knowledge (see col.8, lines 30-32) inside and outside the organization (see col.8, lines 30-32 and col.10, lines 35-40 & 49-50),

an externalization evaluation template (see col.25, lines 17-26 and 64-67) for evaluating an externalization process to express tacit knowledge (see col.8, lines 30-32)

in a comprehensible way (subjective) and convert it into explicit knowledge (see col.10, lines 43-48, 50-53, & 60-63),

a combination evaluation template (see col.25, lines 17-26 and 64-67) for evaluating a combination process to relate such explicit knowledge to other pieces of explicit knowledge inside and outside the organization (see col.13, lines 32-35 and col.38, lines 20-22),

an internalization evaluation template (see col.25, lines 17-26 and 64-67) for evaluating an internalization process to convert explicit knowledge into tacit knowledge (see col.6, lines 39-46; col.8, lines 30-32; col.11, lines 56-65; col.29, lines 11-23; and col.38, lines 24-26),

a computer for reading and outputting said evaluation templates from said database, whereby evaluation results about a member of an organization that are entered in said template are evaluated and the results of said analysis that represent the actual situation of how said member works are outputted (see col.10, lines 40-48);

said system further comprising a tacit knowledge (see col.8, lines 30-32) expression template (see col.25, lines 17-26 and 64-67), said tacit knowledge expression template being read and output by a computer as a reference syntax for expressing tacit knowledge in the externalization process (see col.10, lines 60-63);

a glossary for a tacit knowledge expression template in said database, said glossary being read and output by a computer (see col.8, lines 33-36 and col.24, lines 29-33), terms included in said glossary being applicable to said tacit knowledge

Art Unit: 2155

expression template (see col.5, lines 27-40; col.23, lines 57-64; col.25, lines 30-33; and col.26, lines 29-31); and

said glossary providing terms for responding to inquiries (see col.8, lines 33-36: "searchable" and "include pointers") so that tacit knowledge is converted into explicit knowledge (see col.10, lines 43-48, 50-53, & 60-63) in a common format (inherent).

DEPENDENT:

As per **claim 5**, Bromberg further teaches wherein said system automatically presents a knowledge classification map which indicates inter-relatedness of each said knowledge, when said explicit knowledge is requested by a computer from said database which contains knowledge accumulated after the combination process (see col.38, lines 18-19).

As per **claim 6**, Bromberg further teaches wherein a knowledge consultant manages a database (see col.8, lines 33-35) and a customer organization has a computer which enables use of every template by accessing said database through a two-way communication network (see col.24, lines 29-33).

As per **claim 7**, although Bromberg further teaches of a database also containing accumulated intellectual resource data (see col.8, lines 33-35), Bromberg does not explicitly teach wherein such information in the database is gained by making a contract between said knowledge consultant and owner of intellectual property (subjective).

As per **claim 8**, Bromberg further teaches wherein a manager manages a database, one or more organizations acting as a knowledge consultant has a server

Art Unit: 2155

accessible to said database through a two-way communication network, and a customer organization has a computer that works as a client of said server of said knowledge consultant by accessing thereto through a two-way communication network (see claim 6 rejection above), and said database contains different templates available for said customer through said access to said server (implicit: see col.25, lines 17-26 & 64-67: "dynamic").

As per **claim 9**, Bromberg further teaches wherein a database managed by a manager includes accumulated intellectual property data obtained through making contract between said manager and the owner of said intellectual property (see claim 7 rejection above).

Response to Arguments

5. In response to the argument regarding claim 4, additional reference location have been provided to better teach the claimed limitations. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "regarding answers received by the user") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore,

Bromberg teaches of tying topic "stop points" to the answer of certain questions for faster navigation (see col.26, lines 35-44).

In response to the implicit and inherent teachings of Bromberg, clearly, Bromberg teaches that templates are used to re-evaluate all the data, therefore, it is implied that every teachings of Bromberg within the evaluation process will consist of templates where possible so that all data from the previous evaluation can be re-evaluated (see col.25, lines 17-26). A new reference location has been provided to clearly teach what was previously sought to be inherent in claim 3 (see rejection above). Clearly in response to claim 7, the result of the database and it's content is subjective and not a patentable feature of the invention. In response to claim 8, claim 8 is rejected based on the rejection of claim 6 and the limitation wherein the database contains different templates available for said customer through said access to said server" is sought to be implicit for the reason above.

In response to claim 1, Bromberg clearly teaches the functionality of the four templates and furthermore teaches that templates are employed. A template merely repeats the same process of calculation, evaluation, or conversion for different data and therefore any such process can comprise a template. The template is neither novel nor distinct and therefore does not teach away from prior art.

Applicant's arguments regarding claims 7 and 8, fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

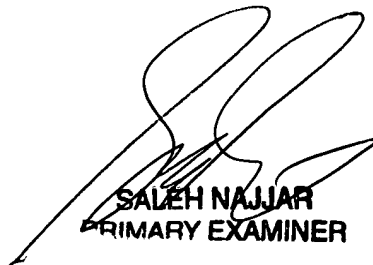
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won



September 12, 2005



SALEH NAJJAR
PRIMARY EXAMINER